

REMARKS

This Amendment is submitted in response to the Office Action dated May 7, 2004. In the Office Action, the Patent Office rejected Claims 1, 2, 5, 7, 15 and 18-21 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,076,166 to *Moshfeghi et al.* in view of U.S. Patent No. 6,266,668 to *Vanderveldt et al.* and further in view of U.S. Patent Application Publication No.: US 2001/0041992 A1 to *Lewis et al.* Additionally, the Patent Office rejected Claims 3, 4, 6, 8-14, 16 and 17 under 35 U.S.C. §103(a) as being unpatentable over *Moshfeghi et al.* in view of *Vanderveldt et al.* in view of *Lewis et al.* and further in view of U.S. Patent No. 6,195,651 to *Handel et al.*

By the present Amendment, Applicant amended Claims 1, 3, 5, 10 and 15 and submits that the amendment to the claims and the remarks and arguments below overcome the rejections by the Patent Office for the reasons that follow.

Applicant also submits herewith a Petition under 37 CFR §1.181 for Withdrawal the Finality of the Office Action as Premature. In Office Action, the Patent Office rejected Claims 1-2, 5, 7, 15 and 18-21 under 35 U.S.C. §103(a) as being unpatentable over *Moshfeghi et al.* (U.S. Patent No. 6,076,166) in view of *Vanderveldt et al.* (U.S. Patent No. 6,266,668) and

further in view of *Lewis et al.* (published U.S. Patent Application Serial No.: US2001/0041992A1). Further, the Patent Office rejected Claims 3-4, 6, 8-14, 16 and 17 under 35 U.S.C. §103(a) as being unpatentable over *Moshfeghi et al.* in view of *Vanderveldt et al.* and further in view of *Lewis et al.* and *Handel et al.* (U.S. Patent No. 6,195,651). *Lewis et al.* was not cited in the prior Office Action, dated January 8, 2004, and is a new ground of rejection that was not necessitated by the Amendment filed on April 12, 2004. Therefore, Applicant submits the Petition for the Withdrawal of the Finality of the Office Action as Premature.

With respect to the rejection of Claims 1, 2, 5, 7, 15 and 18-21 under 35 U.S.C. §103(a) as being unpatentable over *Moshfeghi et al.* in view of *Vanderveldt et al.* and further in view of *Lewis et al.*, Applicant submits that this rejection has been overcome in view of the amended claims and for the reasons that follow.

In the Office Action, the Patent Office alleged:

Moshfeghi et al. do not explicitly indicate the database is searchable via search engine wherein the search engine searches the database for specific attributes. *Vanderveldt et al.* teach a search engine to search web page and searching the attribute or information from the healthcare databases (col. 4, lines 1-18 and col. 5, lines 12-28 and col. 9, lines 35-40). In combination, *Moshfeghi et al.* and *Vanderveldt et al.* do not teach wherein the website

identifies one of the plurality of healthcare providers providing a plurality of healthcare services and wherein one of the pre-defined attributes corresponds to one of the plurality of healthcare services provided by one of the plurality of healthcare providers.

However, Lewis et al. disclose a plurality of healthcare providers posted on the web page or web site for users of the computer network over the internet to access them (page 5, sections 0043 and 0044) and the URL and each hyperlink being associated with a URL is a pre-defined attribute for the place of a web page or web site (page 3, section 31 and 32.)

Independent Claim 1, as amended, requires a method having the step of accessing a form which includes pre-defined information and pre-defined attributes wherein the pre-defined attributes are characteristics of the plurality of healthcare providers. Further, Claim 1 requires the step of selecting the pre-defined information from the form wherein the pre-defined information describes one of the plurality of healthcare providers. Still further, Claim 1 requires the step of selecting one of the pre-defined attributes from the form wherein one of the pre-defined attributes corresponds to healthcare services provided by one of the plurality of healthcare providers. Moreover, Claim 1 requires the step of creating a website which is designed with the pre-defined information and one of the pre-defined attributes.

Additionally, in the Office Action, the Patent Office alleged:

With respect to Claim 15, *Moshfeghi et al.* disclose a computer network for creating personalizing hospital web sites including a plurality of client computer, a personalized web server and retrieving user desired information. *Moshfeghi et al.* do not explicitly indicate the further wherein the website is stored on the database and pre-defined attributes assigned to the website for uniquely identifying the website in the database wherein the pre-defined attributes identify one of the plurality of the healthcare services provided by one of the plurality of healthcare providers. *Vanderveldt et al.* disclose a search engine to search web page and searching the attribute or information from the healthcare databases (col. 4, lines 1-18 and col. 5, lines 12-28 and col. 9, lines 35-40). In combination, *Moshfeghi et al.* and *Vanderveldt et al.* do not teach wherein the website identifies one of the plurality of healthcare providers providing a plurality of healthcare services and wherein one of the pre-defined attributes corresponds to one of the plurality of healthcare services provided by one of the plurality of healthcare providers.

However, *Lewis et al.* disclose a plurality of healthcare providers posted on the web page or web site for users of the computer network over internet to access them (page 5, sections 0043 and 0044) and the URL and each hyperlink being associated with a URL is a pre-defined attribute for the place of a web page or web site (page 3, section 31 and 32.)

Independent Claim 15, as amended, requires pre-defined information which corresponds to one of a plurality of healthcare providers wherein the web page is created with the pre-defined information. Further, Claim 15 requires a list of pre-defined attributes in the database wherein one of the pre-defined attributes is selected from the list wherein one of the pre-defined attributes is displayed on the website wherein one

of the pre-defined attributes describes one of the plurality of healthcare providers.

Moshfeghi et al. merely teach a web system or site which provides web or hypertext pages and/or other data objects that are personalized to the user. Moreover, *Moshfeghi et al.* teach that "the responses from the web server, in particular the personalized web pages and/or data objects provided, are dynamically generated in layer or module 20 using server scripts 22, that utilize personalizing information maintained in the server's file systems or database 24 (pertaining to access privileges and security), database 26 (pertaining to environment profiles), and database 28 (pertaining to user needs, preferences, and usage profiles)."

Vanderveldt et al. merely teach a method and system for searching databases in response to a query which substantially eliminates or reduces disadvantages and problems associated with previous methods and systems for searching databases. Moreover, *Vanderveldt et al.* teach that "the data-mining engine of the present invention evaluates whether the available data accumulated by current search tools are relevant to a user and filters out all non-relevant information, creating a more effective and efficient search engine."

Lewis et al. merely teach an anatomic user interface for

accessing healthcare information for a patient at the point of care. Further, *Lewis et al.* teach that "the anatomic user interface obtains standard-reference anatomic information and patient-specific anatomic information from an anatomic data model and uses this information to generate an anatomic model and uses this information to generate an anatomic model that accurately represents the patient's anatomy." Moreover, *Lewis et al.* teach "that a constraint engine identifies the healthcare information associated with the selected anatomic structure as constrained by factors impacting accepted medical practice, and returns it to the anatomic user interface for display."

Clearly, none of *Moshfeghi et al.*, *Vanderveldt et al.* or *Lewis et al.*, taken singly or in combination, teach or suggest the step of accessing a form which includes pre-defined information and pre-defined attributes wherein the pre-defined attributes are characteristics of the plurality of healthcare providers as required by Claim 1. Further, none of *Moshfeghi et al.*, *Vanderveldt et al.* or *Lewis et al.*, taken singly or in combination, teach or suggest the step of selecting the pre-defined information from the form wherein the pre-defined information describes one of the plurality of healthcare providers as required by Claim 1. Still further, none of *Moshfeghi et al.*, *Vanderveldt et al.* or *Lewis et al.*, taken

singly or in combination, teach or suggest the step of selecting one of the pre-defined attributes from the form wherein one of the pre-defined attributes corresponds to healthcare services provided by one of the plurality of healthcare providers as required by Claim 1. Moreover, none of *Moshfeghi et al.*, *Vanderveldt et al.* or *Lewis et al.*, taken singly or in combination, teach or suggest the step of creating a website which is designed with the pre-defined information and one of the pre-defined attributes as required by Claim 1.

Furthermore, the Patent Office admits that "in combination, *Moshfeghi et al.* and *Vanderveldt et al.* do not teach wherein the website identifies one of the plurality of healthcare providing a plurality of healthcare services and wherein one of the pre-defined attributes corresponds to one of the plurality of healthcare services provided by one of the plurality of healthcare providers." Contrary to assertions of the Patent Office, *Lewis et al.* merely teach that "mass memory 78 also stores a constraint engine 82 formed in accordance with the present invention for providing the anatomic user interface 58 with healthcare information associated with a particular anatomic structure selected by the user." Further, *Lewis et al.* teach that "if the anatomic user interface 58 is being used to order healthcare services, the constraint engine 82 provides the

ICD9 and CPT codes associated with a particular anatomic structure." Still further, *Lewis et al.* teach that "the web page 400 may also include a medical encounter field for entering and displaying medical encounter information, i.e., information that identifies the specific instance of contact between the patient and the healthcare provider." Moreover, *Lewis et al.* teach that "the user may select a prior medical encounter listed in a medical encounter menu retrieved from the patient database 97 or the user may enter a new medical encounter in the medical encounter field."

None of *Moshfeghi et al.*, *Vanderveldt et al.* and *Lewis et al.*, taken singly or in combination, teach or suggest pre-defined information which corresponds to one of a plurality of healthcare providers wherein the web page is created with the pre-defined information as required by Claim 15. Moreover, none of *Moshfeghi et al.*, *Vanderveldt et al.* or *Lewis et al.*, taken singly or in combination, teach or suggest a list of pre-defined attributes in the database wherein one of the pre-defined attributes is selected from the list wherein one of the pre-defined attributes is displayed on the website wherein one of the pre-defined attributes describes one of the plurality of healthcare providers as required by Claim 15.

The Patent Office admits that *Moshfeghi et al.* and

Vanderveldt et al. do not teach that the website identifies one of the plurality of healthcare providers providing a plurality of healthcare services and wherein one of the pre-defined attributes corresponds to one of the plurality of healthcare services provided by one of the plurality of healthcare providers. *Lewis et al.* merely teach that "the ICD9 tab 430 includes an ICD9 code menu field 444 listing all of the possible ICD9 codes that are valid for the selected anatomic structure." Further, *Lewis et al.* teach that "this list of all possible ICD9 codes is returned to the anatomic user interface 58 along with the anatomic structure by the anatomic data model 84 during the anatomic structure retrieval subroutine." Still further, *Lewis et al.* teach that "the treatment plan menu allows the user to select the desired treatment plan from a list of appropriate treatment plans related to the selected anatomic structure."

Moreover, with respect to the rejection of Claims 1, 2, 5, 7, 15 and 18-21 under 35 U.S.C. §103(a), one of ordinary skill in the art would never have been motivated to modify *Moshfeghi et al.* with *Vanderveldt et al.* and *Lewis et al.* in the manner suggested by the Patent Office in formulating the rejection of the claims under 35 U.S.C. §103(a). It is submitted that the question under §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary

skill in this art. In re Simon, 461 F.2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most if not all elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicant's invention, either separately or used in other combinations. A teaching, suggestion, or incentive must exist to make the combination made by Applicant. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

With the analysis of the deficiencies of *Moshfeghi et al.*, *Vanderveldt et al.* and *Lewis et al.* in mind, as enumerated above, no reason or suggestion in the evidence of record exists why one of ordinary skill in the art would have combined *Moshfeghi et al.* with *Vanderveldt et al.* and *Lewis et al.* in the manner suggested by the Patent Office in formulating the

rejection under 35 U.S.C. §103(a). Therefore, *prima facie* obviousness has not been established by the Patent Office as required under 35 U.S.C. §103(a).

Further, Applicant submits that the Patent Office is merely "piece-mealing" references together providing various teachings and limitations of Applicant's method and system to deprecate the claimed invention. Of course, hindsight reconstruction of Applicant's invention is impermissible.

In view of the foregoing remarks and amendments, Applicant respectfully submits that the rejection of Claims 1, 2, 5, 7, 15 and 18-21 under 35 U.S.C. §103(a) has been overcome and should be withdrawn. Notice to that effect is requested.

With respect to the rejection of Claims 3, 4, 6, 8-14, 16 and 17 under 35 U.S.C. §103(a) as being unpatentable over *Moshfeghi et al.* in view of *Vanderveldt et al.* and further in view of *Handel et al.*, Applicant respectfully submits that the rejection has been overcome by the amendment to the independent Claims 1 and 15 and was improper since none of *Moshfeghi et al.*, *Vanderveldt et al.*, *Lewis et al.* and/or *Handel et al.*, taken singly or in combination, teach or suggest the critical steps and features defined in Claims 1 and 15, respectively, from which Claims 3, 4, 6, 8-14, 16 and 17 depend. Notice to that effect is requested.

Claims 2-14 depend from independent Claim 1; and Claims 16-21 depend from independent Claim 15. These claims are further believed allowable over the references of record for the same reasons set forth with respect to their parent claims since each sets forth additional steps and elements of Applicant's method and system, respectively.

In view of the foregoing remarks and amendments, Applicant respectfully submits that all of the claims in the application are in allowable form and that the application is now in condition for allowance. Further, Applicant submits that neither further search nor consideration would be necessitated by entry of this Amendment; therefore, entry of this Amendment is proper and should be effected.

If, however, any outstanding issues remain, Applicant urges the Patent Office to telephone Applicant's attorney so that the same may be resolved and the application expedited to issue. Applicant requests the Patent Office to indicate all claims as



allowable and to pass the application to issue.

Respectfully submitted,

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CERTIFICATE OF MAILING

I hereby certify that this **Amendment After Final** are being deposited with the United States Postal Service as First Class Mail in an envelope addressed to Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on August 9, 2004.

Brian M. Mattson